

Application No. 09/767,810

Atty Docket No. INXT 1014-1

**REMARKS**

Claims 1-99 are pending, claims 1, 4, 21, 40 and 81 having been previously amended. Claims 7, 11, 24, 28, 45, 51, 65, 71, 84 and 91 are rejected under 35 U.S.C. § 112. All claims are rejected under § 103(a).

Some continuity has been lost, due to the change in Examiners between office actions.

**Rejection Under 35 U.S.C. § 112 of Claims 7, 11, 24, 28, 45, 51, 65, 71, 84 and 91**

The Examiner rejects **claims 7, 11, 24, 28, 45, 51, 65, 71, 84 and 91** under 35 U.S.C. § 112 "due to the lack of a description of what forms are considered standard, or canonical" (OA 2). As used in these claims, no particular canonical form is required, just a consistent form. This meaning appears at the bottom of page 4 of the application:

5. A system to normalize the email send date, instances of dates with the email body and attachments, and instances of currency within the email body and attachments to canonical (conforming to a general rule or acceptable procedure) representations.

This description having been identified for the Examiner, Applicants respectfully request that the § 112 rejection be withdrawn.

**Rejection Under 35 U.S.C. § 103(a) of Claim 61**

The Examiner rejects **claim 61** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149) in view of Pratt et al. (US 67721441). This claim includes the limitations:

*a computer, including an electronic mail client having programmatic resources for composing an electronic document having a header and a body, and for sending electronic documents to one or more recipients; and programmatic resources coupled with the electronic mail client in the computer which*

*process said electronic document to identify semantic foci within the document;*

*create a meta-content index corresponding to said semantic foci; and*

*combine said meta-content index with the header and the body to provide an enhanced document,*

These limitations are not found in Ohmura, because, as the Examiner acknowledges, Ohmura relies on a user to identify (rubber band select) sections of web pages to

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extract as images, instead of using a program for the identification. Images are produced from the web pages, not words, dates or numbers.

The Examiner proposes to combine Ohmura with Pratt (OA 3-4). The Examiner's entire reasoning is, "Pratt discloses automatic identification of semantic foci (column 9, lines 5-41). [¶] It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to have combined Ohmura's method with Pratt's method, since it would have allowed a user to obtain a weighted listing of documents (Pratt: column 9, lines 5-41)." The Examiner's view of how the references would be combined is as clear as mud – not a word is devoted to how the combination of dissimilar technologies would work. While this is not unusual to find in an Official Action, it is not very helpful either.

**The Practical Problem of Combining Ohmura and Pratt**

Ohmura and Pratt are very dissimilar. Ohmura provides a system that supports manual extraction of "stickers" from web pages and inserting them in e-mails that are then trackable. The stickers are facsimile images of web page sections, in an image format instead of a markup format. Pratt provides a multi-tier index system. In context, Pratt is assigned to Novell and mentions products complementary to Novell's once-popular network server operating system (NOS). A decade ago, Novell's server architecture dominated the law firm market, for instance, where documents are generated and added continuously to a server. Pratt discloses a multi-tier index system that facilitates continuous addition to an index, background merger of sub-indexes and selective searching of only relevant sub-indexes, in response to a query. A manual tool for cutting and pasting web page images into e-mails does not have much in common with a multi-tiered index for Novell's NOS.

There is no straightforward combination of Pratt's index technology and Ohmura's sticker technology. The Examiner seems to suggest that Pratt would automate Ohmura's manual extraction of stickers (OA 3). At least, that would complement Ohmura's approach to identifying semantic foci, which the Examiner describes as "a user manually identifies semantic foci and a program assists in processing (extracting) the information." *Id.* Pratt does not include technology that would automate manual extraction of stickers. The passages of Pratt that the Examiner cites discuss the value of indexing noun phrases, in addition to indexing single words. See,

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col. 9, lines 5-41. Indexing noun phrases cannot properly be substituted for manual extraction of "stickers" from web pages – Ohmura's technology would not use the same method, work the same way, or produce the same result if one attempted to substitute Pratt's indexing of noun phrases for manual extraction of interesting "stickers" from web pages.

In addition, looking at the combination beginning with Pratt, it is not reasonable to propose dumping Pratt's multi-tier index structure into the header of an enhanced electronic document.

Even if part of the multi-tiered index were inserted into an e-mail header, it would not read on Suppose that Pratt's index were applied to a web page, which is Ohmura's source (Ohmura FIG. 9), and something derived from the web page was "stickered" into an e-mail. The sticker, which the Examiner considers the *meta-content index corresponding the said semantic foci* does not relate to the original content of the e-mail. The e-mail is a delivery vehicle, not an original document enhanced with meta-content index reflecting its original semantic foci. This is not as claimed.

A word choice in Pratt that may be leading us astray is repeated use of "semantic" in various contexts. For instance, "The search decision table 22 can also become a semantic access table that can direct searchers to the most fruitful portion of the index space to search." Col. 4, line 65 – col. 5 line 2. "Putting the [noun] phrases and their combinations ... into the index and the search decision table as a single entry adds to the semantic focus that can be obtained from the search decision table." Col. 9, lines 35-38. As Applicants understand Pratt's use of semantic in the context of noun phrases, Pratt indexes all noun phrases in all documents submitted, using a multi-tier index and the top level index (the search decision table) helps a person focus their search strategy. Comprehensively indexing documents, even adding noun phrases to the index, is not as claimed.

**Legal Problems: Lack of Evidentiary Quality Suggestion to Combine**

In addition to the practical problem of what it would mean to use Pratt to automate Ohmura's manual selection of stickers, there are a host of legal problems with the proposed combination. Some dominant legal problems are lack of an evidentiary quality suggestion, teaching or motivation to combine, that reproducing the claimed system depends on the claims to suggest the combination (hindsight), that automating

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Ohmura's manual selection of stickers would render Ohmura unsuitable for sharing of interesting parts of web pages by e-mail, and that substituting noun phrase detection for manual rubber banding of subjectively interesting web page sections would change Ohmura's principle of operation. The third and fourth problems come from the PTO's examiner training materials, as well as the MPEP.

The importance of an evidentiary quality teaching, suggestion or motivation to combine was emphasized by the Federal Circuit several years ago. *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). This case has been added to the guidance in the MPEP § 2143.01 regarding obviousness analysis. The rule of *In re Lee* is that generalities will not be accepted on appeal. **Specificity is required** for an examiner to satisfy the *prima facie* burden for combining references; only by showing some objective evidence of teaching in the prior art or by specific identification of a principle known to one of ordinary skill can meet the legal requirement. The court reasoned, 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to **the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed**"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and

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Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

*See, Gechter v. Davidson*, 116 F.3d 1454, 1457-60, 43 U.S.P.Q.2d (BNA) 1030 (Fed. Cir. 1997) (finding arbitrary the Board's finding of anticipation because of an inadequate explanation on how the reference disclosed claim elements, vacating, and remanding). This rule applies to combining features from different sources.

The outcome of cases decided even before *In re Lee* makes it clear that real evidence is required to prove an asserted teaching, suggestion or motivation to modify one or more references, to combine the references. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with regard to non-metallic fibers).

The MPEP embraces the case law, in § 2143.01, requiring that the Examiner produce objective evidence of a teaching, suggestion or motivation to combine the references, without using the claims as a roadmap:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). *See also >In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *< In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Both the case law nor the MPEP require evidence of a suggestion, teaching or motivation to combine the claimed elements in the manner claimed.

The Examiner's briefly proposed motivation, from Pratt, is to allow "a user to obtain a weighted listing of documents" (OA 3-4). This passage does not motivate reproducing the claimed combination. Pratt by itself is much more satisfactory for the

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motivated purpose than Pratt combined with Ohmura. The proposed motivation does not lead to the claimed result of providing an enhanced electronic document into which meta-content index material has been combined, as Pratt's weighted listing of documents comes from the search decision table, not from combining meta-context index material with a particular electronic source document.

**Legal Problems: Hindsight**

Another problem with the proposed combination is that it uses the apparent results of the claimed method as a blueprint or roadmap for combining references that lack any teaching or suggestion to combine. This approach is prohibited by the "as a whole" rule of Section 103 and is sometimes called hindsight. The Federal Circuit explained in *Ruiz v. A.B. Chance*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d (BNA) 1686 (Fed. Cir. 2004):

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention **"as a whole."** Inventions typically are new combinations of existing principles or features. *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). **The "as a whole" instruction in title 35 prevents evaluation of the invention part by part.** Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided **further assurance of an "as a whole" assessment** of the invention under § 103 by **requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner.** In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. *See In re Rouffet*, 149 F.3d 1350, 1355- 56 (Fed. Cir. 1998).

*See, Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337, 75 U.S.P.Q.2d (BNA) 1051 (Fed. Cir. 2005) (reciting *Ruiz* rule; "simply identifying all of the

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elements in a claim in the prior art does not render a claim obvious").

Nothing about the proposed motivation suggests or teaches the claimed combination. Any suggestion to produce the claimed combination is coming from the claims, not the references.

**Legal Problems: Change Principle of Operation**

Next, combining the references would improperly modify the primary reference's principle of operation. MPEP § 2143.01 explains:

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

**If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.** *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

*Accord, Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1569, 38 U.S.P.Q.2D (BNA) 1281 (Fed. Cir. 1996) (equivalence to redesign reversed, as principles of operation obviously not the same); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 U.S.P.Q.2D (BNA) 1434 (Fed. Cir. 1988) (invalidity reversed, as principles of operation antithetical and no teaching or suggestion to combine). "As a proposed modification or combination of the prior art should not destroy a reference, the proposed modification or combination should not change the principle of operation of the reference. *In re Ratti*, 270 F. 2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). **This is true even if the combination proposed is operative.**" Barry R.A. Weinhardt, M. Reinhart, *Obviousness Under 35 U.S.C. 103 Basic Student's Manual*, p. 25-26 (U.S. P.T.O. Office of Patent Policy Dissemination, Rev. 4 1998) (explaining, M.P.E.P. 2143.01).

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Ohumra's principle of operation is to assist a user in passing along what they see to someone else and tracking where the "sticker" goes after that. Ohumra's user is interested in feedback on something that they saw on a web page. Human editorial selection is essential to Ohumra. Using Pratt as suggested by the Examiner would defeat Ohumra's principle of operation.

**Legal Problems: Ohmura's Intended Purpose**

Combining the references would render Ohmura unsuitable for its intended purpose. Here, the issue boils down to whether some combination with Pratt would produce the same selections as an editorial user, so that the feedback from tracking automatically extracted stickers (if the combination generated stickers ...) would be interesting. To ignore the feedback loop would render the Ohmura unsuitable for its intended purpose.

The rule of MPEP § 2143.01 at 2100-131 (Rev. 2, May 2004) is:

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART  
UNSATISFACTORY FOR ITS INTENDED PURPOSE

**If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.** *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

*See, also, Barry et al., supra*, p. 24.

Again, Pratt is assigned to Novell. Substituting an enhanced index structure for human editorial selection to elicit feedback would improperly ignore Ohmura's intended purpose.



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Because the proposed combination would not reproduce the claimed method and because the combination is legally improper for four reasons, claim 61 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 1, 40, and 81**

The Examiner rejects **claims 1, 40, and 81** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149) in view of Pratt et al. (US 67721441). These claims include the limitations such as found in claim 1:

*A method for processing an electronic document adapted for delivery to one or more recipients, the electronic document including a header and a body, the method comprising:*

*processing the electronic document using a program to automatically identify semantic foci;*

*creating a meta-content index corresponding to said semantic foci;*  
*and*

*combining said meta-content index with the header and the body to provide an enhanced document.*

Claims 40 and 81 present an article of manufacture corresponding to and a product produced by the process described in claim 1. The automatic processing limitation is not found in Ohmura, because, as the Examiner points out, the user in Ohmura identifies data, instead of a program doing so.

The combination of Ohmura and Pratt does not automatically identify semantic foci as claimed or as the primary reference Ohmura does. All that Pratt does is create a multi-tiered index that a user can apply with a semantic focus. It does not intend to automatically identify semantic foci. Moreover, the combination of references is improper for the practical and legal reasons state above. There is no teaching, suggestion or motivation to combine the references in quite the arrangement claimed.

Therefore, claims 1, 40, and 81 should be allowable over Ohmura.

**Rejection Under 35 U.S.C. § 102(e) of Claims 3, 22, 43, 63 and 83**

The Examiner rejects **claims 3, 22, 43, 63 and 83** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149) in view of Pratt et al. (US 67721441). These claims includes the limitations:

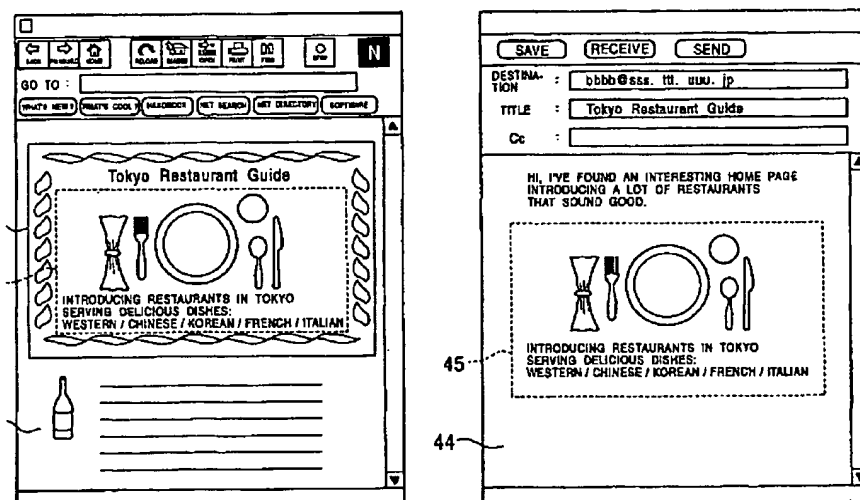
*wherein said electronic document comprises an electronic mail document*

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These limitations are not found in the combination of references. We point out that *said electronic document* has two antecedent references: "the electronic document" which is being processed to automatically identify semantic foci; and "an enhanced document" that results from the processing, before output. The claims clearly state that the electronic document which the program automatically processes to identify semantic foci is an e-mail. An output document might correspond to the claimed enhanced document or something later in processing.

It is clear from Ohmura that the document on which the user operates to manually select data is a web page, not an e-mail. From FIG. 9:



One can see that the sticker comes from a web page and is pasted into the e-mail. The sticker, which the Examiner considers the *meta-content index corresponding the said semantic foci*, does not relate to the original content of the e-mail. The e-mail is a delivery vehicle, not an original document enhanced with meta-content index reflecting its original semantic foci.

In the response to arguments section (OA 20-21), the Examiner cites Ohmura col. 11, lines 40-63, which refers to copying a sticker from one e-mail to another. This fails for the same reason as given above: the sticker pasted into the e-mail does not result in an original document enhanced with meta-content index reflecting its original semantic foci. The source and destination e-mails a sticker that reflects some web page having different content than either e-mail.

Therefore, claims 3, 22, 43, 63 and 83 should be allowable over Ohmura.

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**Rejection Under 35 U.S.C. § 103(a) of Claims 4, 23, 44, 64 and 83**

The Examiner rejects **claims 4, 23, 44, 64 and 83** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149) in view of Pratt et al. (US 67721441). In this section, the Examiner addresses combining the references. Typically, claim 4, which depends from claim 3, includes the limitations:

*including converting said electronic mail document to a markup language format, and wherein said meta-content index comprises one or more objects expressed in said markup language adapted for presentation with the body in said enhanced document*

These limitations are not found in the combination of references. Read together with claim 3, these limitations involve converting a source e-mail, from which semantic foci have been automatically identified, into a markup language format. Ohmura's e-mail is only a transport vehicle, not a source document.

Regarding these claims, we previously made much of how combining Ohmura with Fujii (cited in the prior OA) would render Ohmurra unsuitable for its intended purpose and change its principle of operation. We recited, "A proposed modification should not 'destroy a reference' by rendering the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1 127 (Fed. Cir. 1984)." Barry et al., *supra*, p. 24. Combining the references would change the basic principle of operation in Ohmura. "As a proposed modification or combination of the prior art should not destroy a reference, the proposed modification or combination should not change the principle of operation of the reference" Barry et al., *supra*, pp. 25-26.

We appreciate that the Examiner withdrew the prior rejections in light of this argument, but nothing in the present combination overcomes the problems of the prior combinations. The practical and legal problems with combining Ohmura and Pratt apply as strongly to these claims as to claim 61.

Therefore, claims 4, 23, 44, 64 and 83 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 5, 24, 45, 65 and 84**

The Examiner rejects **claims 5, 24, 45, 65 and 84** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149) in view of Pratt (US 67721441) in further view

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of Hong et al. (US 5710883). Typically, claim 5, which depends from claim 3, includes the limitations:

*wherein said electronic document comprises a document in a format compliant with a standard MIME format*

These limitations are not found in the combination of references. Read together with claim 3, these limitations describe enhancing a source e-mail that begins in MIME format, from which semantic foci have been automatically identified. Ohmura's e-mail is only a transport vehicle, not a source document, whether the sticker is being applied directly from a web page or by copying from one e-mail to another. The combined teaching is to make a sticker and paste it into a different document than the source of the sticker. Referring to Hong does not change this.

This rejection suffers the same practical and legal problems of combination as rejection of claim 61. Adding a third reference compounds the defects of the proposed combination.

Therefore, claims 5, 24, 45, 65 and 84 should be allowable over Ohmura in view of Pratt and Hong.

**Rejection Under 35 U.S.C. § 103(a) of Claims 6-7, 25-26, 46-47, 66-67 and 85-86**

The Examiner rejects **claims 6-7, 25-26, 46-47, 66-67 and 85-86** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149 in view of Pratt (US 67721441) in further view of Engst, *Visual Quickstart Guide: Eudora for Mac and Windows* (1997). These claims include limitations related to a temporal relationship between the document date and the at least one other date, which we call "temporal proximity." Dates that closely match the target date may be one color and dates further away another color. See, e.g., claim 8. This is different from color-coding the dates on some arbitrary basis. Temporal proximity coding is not found in Ohmura in view of Pratt and Engst.

Claim 6 includes the limitations:

*wherein said semantic foci includes at least one date within the body, and including:*

*identifying a document date within the header; and*

*associating a presentation attribute to said at least one date in said meta-content index, the presentation attribute based upon a temporal relationship between the document date and the at least one date.*

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The Examiner relies on a sample returned e-mail (Engst FIG. 18) which includes more than one date: dates include the return date and the returned e-mail.

An e-mail that includes multiple dates, even in a sensible order, does not meet the temporal coding limitations. Returning an e-mail does not involve identifying a document date within the header, and coding a date in the body with a presentation attribute based upon a temporal relationship (color coded as close or distant, for instance) between the dates in the header and body. The Examiner labels the return date as the *document date within the header* and an origin date as *said at least one date* in the body. With these labels, it is easy to see that Engst does not perform any operation based on a temporal relationship between the return date and the origin date – close and distant dates are treated exactly the same way. The return and origin dates appear uncoded; no presentation attribute is associated with the origin date. And, no presentation attribute for the origin date is added to the meta-content index. In other words, the only coincidence between claim 6 and Engst is that Engst is an example of an e-mail with multiple dates on its face, some in the header and others in the body.

The combination of Engst with Ohmura in view of Pratt is almost comical. Engst shows a source document that is a returned e-mail. Pratt indexes the e-mail and automatically creates some kind of sticker. The sticker is pasted into another e-mail, presumably showing less than the whole returned e-mail. No one would ever build such a combination and building it would not replicate claim 6.

The Examiner proposes to motivate combining Engst with Ohmura and Pratt (OA 14) “since it would have allowed the user to visually track the origins of a document.” We guess that the Examiner is relying on Ohmura for this motivation, as no citation is given. The purpose of visually tracking the origin of a document is better served by Engst or Ohmura by themselves than by a three-way combination. Engst gives the origin of a returned e-mail efficiently and succinctly. Stickering would be a wasted complication, which no one would be motivated to add. Ohmura starts with a sticker manually composed from a web site. Nothing about Engst would enhance Ohmura’s tracking method. That said, how would Pratt relate to this proposed motivation?

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The practical and legal problems identified above apply with even greater force to rejection of claim 6 than to claim 61, because this rejection adds a third divergent technology to the combination.

Therefore, claims 6-7, 25-26, 46-47, 66-67 and 85-86 should be allowable over Ohmura in view of Engst.

**Rejection Under 35 U.S.C. § 103(a) of Claims 8, 27, 48, 58 and 87**

The Examiner rejects **claims 8, 27, 48, 58 and 87** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149 in view of Pratt (US 67721441) in further view of Engst and still further (telescopic??) view of Alder (US 6138130). These claims further specify temporal proximity color coding.

Alder's use of color at col. 16, lines 17-25, is to distinguish in a trading spreadsheet between options and commodities, for instance. *Id.* There is no teaching, suggestion or motivation to apply color to temporal coding of the relationship between a header date and a body date, as claimed. □

The Examiner's motivation to allow a user to quickly differentiate between object types does not motivate the claimed application of color coding. Nor does it say anything about why "an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner." *Ruiz, supra*. There is no evidentiary quality teaching, suggestion or motivation to combine.

Applicants respectfully submit that claims 8, 27, 48, 58 and 87 should be allowable over Ohmura in view of Pratt, Engst and Alder.

**Rejection Under 35 U.S.C. § 103(a) of Claims 11, 13, 28, 30, 51, 53, 71, 73, 90 and 92**

The Examiner rejects **claims 11, 13, 28, 30, 51, 53, 71, 73, 90 and 92** under 35 U.S.C. § 103(a) as unpatentable over Ohmura (US 6138149) in view of Pratt (US 67721441) in further view of Alder (US 6138130). Typically, claims 11 and, which depend from claim 9, includes the limitations:

*[9] wherein said semantic foci includes a plurality of types of information, the plurality of types including one or more of email addresses, URLs, dates, currency values, organization names, names of people, names of places, names of products, names of drugs, names of sports teams, names of*

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*diseases, and phone numbers.*

*[11]. wherein in one of the plurality of types comprises currency values, and including converting the currency values to a canonical form*

*[13] including color coding said electronic version of said index and said semantic foci in said body according to said plurality of types.*

These limitations are not found in the combination of references.

This time, the Examiner relies on Alder for having a spreadsheet that handles financial data. Col. 7, lines 20-37. Cells of a spreadsheet are not semantic foci, as claimed. Names of drugs or sports teams do not have distinct cell types in a spreadsheet.

Combining Alder with Ohmura and Pratt would produce an odd looking part of a spreadsheet document, automatically selected (without applying human judgment) and pasted as a sticker into an e-mail. Ohmura, Pratt and Alder, as inventors, would turn over in their graves at such a suggestion. Claim 11 would not be reconstructed from by combining these reference.

As for color coding by automatically identified semantic type, in claim 13, Alder is more limited, color coding manually input cells of a spreadsheet.

Applicants respectfully submit that claims 11, 13, 28, 30, 51, 53, 71, 73, 90 and 92 should be allowable over Ohmura in view of Sheffield in further view of Doerre et al.

**Rejection Under 35 U.S.C. § 103(a) of Claims 10, 50, 70 and 89**

The Examiner rejects **claims 10, 50, 70 and 89** under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view of Pratt. Claim 10, typically, adds to claim 9 the limitations:

*wherein said meta-content index comprises entries sorted by the plurality of types*

These limitations are not found in the proposed combination.

The Examiner relies on a passage of Pratt from column 9:

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Search decision tables can also be used for linguistic topic 5  
identification. For instance, assume twenty-five noun  
phrases are returned for a document in ranked order of what  
is perceived to be the most important topics in the document.  
The top five of these topics are stored in the item record in  
the index and index all of the topics as well as the regular full 10  
text. These topics are flagged with a special field number and  
give high relevance numbers to these topics. In addition to  
the emphasis and field weights of individual words that  
come from these topics, the search decision table could also  
contain actual topic noun phrases and subphrases. Two 15  
examples of these are the topic terms "swim wear" and  
"concentration camp." Each of these phrases has a special-  
ized meaning in combination that provides a much more  
focused semantic search than just the individual terms of the  
topic phrases. For instance, when looking at a grocery store 20  
aisle, one sees the brand names and the food names, not  
ingredient lists and preparation directions. One sees "peanut  
butter" and "Tang" and "frozen dinners" and other excellent  
semantic category discriminator words. These topic noun  
phrases are preferably marked as special rows in the search 25  
decision table so they would be distinguished from words in  
the document. Each topic would have its own row in the  
search decision table similar to a high frequency word.  
These would also be important weighted terms in deciding  
which index a new document might best be clustered with. 30  
For example, a Mar. 17, 1999 ABC News article on a car  
powered by a hydrogen/oxygen fuel cell might have topics  
like: "hydro-powered cars," "fuel cell powered cars," "Dim-  
lerChrysler AG," "hydro-powered cars," "NECAR 4," and  
"automobile fuel systems." Putting these phrases and their 35  
combinations (e.g. index "fuel cell" as well as "fuel cell  
powered cars") into the index and the search decision table  
as a single entry adds to the semantic focus that can be  
obtained from the search decision table. The table is able to  
route the user to the appropriate index using word profiles 40  
and attributes, and/or ranked topics.

All noun phrases in this passage have the object type "noun phrase". There are not  
separate types for "swim wear" and "concentration camp". While noun phrases may  
have their own rows in an index, the degenerate case of one type, "noun phrase",  
sorted alphabetically in an index, does not read on claim 11, which specifies assigning  
and sorting by a plurality of types.



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Applicants respectfully submit that claims 10, 50, 70 and 89 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 12, 29, 52, 72 and 91**

The Examiner rejects **claims 12, 29, 52, 72 and 91** under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view of Pratt and in further view of Logan et al. (US 5732216). Claim 12, which depends from claim 9, includes the limitations:

*including annotating said semantic foci within said body.*

These limitations are not found in the proposed combination.

Just saying that the motivation "would have allowed a user to provide commentary about a document" is not evidence sufficient to satisfy MPEP § 2143.01, *In re Lee*, or MPEP § 2144.03, which require evidence to support the three way combination. (Seriously, what would the combination look like?)

Applicants respectfully submit that claims 12, 29, 52, 72 and 91 should be allowable over Ohmura in view of Logan et al.

**Rejection Under 35 U.S.C. § 103(a) of Claims 14, 31, 54, 74 and 93**

The Examiner rejects **claims 14, 31, 54, 74 and 93** under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view Pratt. Claim 14 includes the limitations:

*including associating hyperlinks with said semantic foci, and incorporating said hyperlinks into one of said meta-content index and said body.*

These limitations are not found in the proposed combination.

The Examiner refers to the hyperlinks that Ohmura uses to point from the e-mail containing the sticker back to the source web page. This does not meet the claimed limitations, which specify hyperlinking within a single electronic document, from the meta-content index (or body) to the semantic foci.

Applicants respectfully submit that claims 14, 31, 54, 74 and 93 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 15, 34, 55, 75 and 94**

The Examiner rejects **claims 15, 34, 55, 75 and 94** under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view Pratt. Claim 15 includes the limitations:

*wherein said meta-content index comprises labels facilitating parsing of the enhanced document.*

These limitations are not found in the proposed combination.

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We think that the Examiner misunderstands the discussion in Pratt column 9. As we read that discussion, a smart searcher can use the search decision table, at the top level of the multi-tiered index, in a certain way. This top level of the multi-tiered index has nothing to do with parsing an enhanced document – the proposed combination does not generate an enhanced document, as described above.

Applicants respectfully submit that claims 15, 34, 55, 75 and 94 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 16, 35, 56, 76 and 95**

The Examiner rejects claims 16, 35, 56, 76 and 95 under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view Pratt. Claim 16 includes the limitations:

*wherein said electronic document includes an attachment, and said processing includes analysis of the attachment.*

These limitations are not found in the proposed combination.

The Examiner's analysis ignores that the original document and the enhanced documents are variations of one another. Ohmura's original document, refereed to here as *said electronic document*, is a web page which does not have attachments.

Applicants respectfully submit that claims 16, 35, 56, 76 and 95 should be allowable over Ohmura in view Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 17-18 36-37, 57-58, 77-78 and 96-97**

The Examiner rejects claims 17-18 36-37, 57-58, 77-78 and 96-97 under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view of Pratt. Claims 17-18 includes the limitations:

*including generating a summary of said electronic document, and including the summary in the enhanced document.*

*wherein said electronic document includes an attachment, and including generating a summary of the attachment, and including the summary in the enhanced document.*

These limitations are not found in the proposed combination.

The output of Ohmura, an image and a URI, is not a summary. The first passage cited, col. 1, line 66- col. 2, line 13, refers to a keyword index, it does not disclose a method of generating a summary. The second passage, col. 7, lines 1-10, describes adding some address information to something, but it is not a summary added to an

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enhanced document. Again, Ohmura does not produce an enhanced document, it produces an e-mail with a sticker excerpted from a different document.

Applicants respectfully submit that claims 17-18 36-37, 57-58, 77-78 and 96-97 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 19, 38, 59, 79 and 98**

Claims 19, 38, 59, 79 and 98 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohmura in view of Pratt. These claims include limitations such as:

*wherein said header includes text suggesting a key subject, and including generating a summary of said electronic document based upon the key subject, and including the summary in the enhanced document*

In claim 1, the antecedent reference to "said header" is "the electronic document including a header and a body." Ohmura takes a web page as the electronic document input. It says nothing about extracting metadata from a web page or about creating a summary of the web page. Instead of processing the web page as text, Ohmura converts it to an image format to create a sticker. No summarization is performed, as we explained above in the context of claims 17-18. What Ohmura does is not as claimed.

Therefore, claims 19, 38, 59, 79 and 98 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 20, 39, 60, 80 and 99**

The Examiner rejects **claims 20, 39, 60, 80 and 99** under 35 U.S.C. § 103(a) as being unpatentable over Ohmura in view of Pratt. These claims include limitations such as:

*wherein said meta-content index includes a summary of all or part of the electronic document*

The Examiner repeats the same argument and cites the same passages as used to reject claims 17 et seq. Accordingly, we refer back to claim 17 for the response to this rejection

Applicants respectfully submit that claims 20, 39, 60, 80 and 99 should be allowable over Ohmura in view of Pratt.

**Rejection Under 35 U.S.C. § 103(a) of Claims 32-33**

The Examiner rejects **claim 32** under 35 U.S.C. § 103(a) as unpatentable over Ohmura in view of Pratt.

*including adding presentation attributes to entries in said meta-content index*

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*according to said plurality of types.*

*including adding presentation attributes to entries in said meta-content index within one of said plurality of types, according to relationships among said entries within said one of said plurality of types.*

These limitations are not found in the proposed combination.

The Examiner relies on Alder, col. 16, lines 17-25. Alder's use of color in this passage is to distinguish in a trading spreadsheet between options and commodities, for instance. *Id.* There is no teaching, suggestion or motivation to apply color to temporal coding by type or to signify relationships between meta-context index entries within a type.

As described above, Ohmura does not include a plurality of codable types of semantic foci. (Nor does it include semantic foci.) An index sticker consists of image data and a URI. It makes no sense to color code image data or a URI by semantic foci type, as claimed. There is no concept in Ohmura, Pratt or Adler of extracting semantic foci, so the combination cannot supply the missing element.

The Examiner has not provided evidentiary quality support to motivate combining the three very different technologies described in the references.

The Examiner has not provided evidentiary quality support to motivate combining the references, however that combination is envisioned.

Applicants respectfully submit that claims 32-33 should be allowable over Ohmura in view of Pratt.

### **CONCLUSION**

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these amendments.

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The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone (415) 902-6112 most other times.

Respectfully submitted,



Dated: October 26, 2005

Ernest J. Beffel, Jr., Reg. No. 43,489

HAYNES BEFFEL & WOLFELD LLP  
P.O. Box 366  
Half Moon Bay, CA 94019  
(650) 712-0340 phone  
(650) 712-0263 fax